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In re Patent No. KENT BARKER ET AL.
Appl. No.: 10/614,577
Filed July 7, 2003
For: Electrical Connection Apparatus and Method
For an Airbag Inflator

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: **DECISION ON PETITION**
: **37 CFR 1.144**
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Applicant filed a "PETITION TO THE DIRECTOR UNDER 37 CFR § 1.144" on July 29, 2004. This paper will be treated as a "request for clarification."

A restriction requirement was mailed on June 9, 2004. In response, the Applicant filed petition to the Director to review the election requirement and requested to vacate the same.

The Applicant asserts that the Examiner required an election between fifteen different groups of species. Each group of species represents alternative, but closely related features of the disclosed embodiments and requiring Applicants to make multiple elections between fifteen different groups of species of closely related embodiments of the claimed invention is inequitable. The Applicant further asserts that requiring Applicant to make multiple elections between fifteen different groups of closely related subject matter requires Applicant to review in detail the specification and claims and identify all claims that read on each group of species. Essentially, the Examiner is shifting the burden of examination onto the Applicants. The Examiner has required an election between any alternative embodiments of the present invention. Such a requirement is overly restrictive and burdensome. The Examiner should not be permitted to shift the burden of examination upon the Applicants, when it can easily be examined at one time because of the relatedness of each disclosed alternative embodiment of the present invention.

The Applicant further asserts that requiring an election between fifteen different groups of alternative features of the present invention may unnecessarily delay issuance of the claimed

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subject matter and may significantly increase the monetary burden on Applicants in prosecuting the claims.

Title 37 C.F.R. § 1.144 sets forth the requirements for a Petition from the requirement for restriction.

§ 1.144 Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

In regards to Applicant's assertion that an election between any alternative embodiments of present invention is overly restrictive and burdensome and that the examiner should not be permitted to shift the burden of examination upon the Applicant, when it can be examined at one time because of the relatedness of each disclosed alternative embodiment of the present invention. M.P.E.P. 803 states that "an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i))." The instant application contains four distinct inventions. As such, restricting the application to one invention is proper for search and examination. MPEP 803 further states "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." In this particular situation, there is clearly a serious burden on the examiner to search and examine the entire application since the claims contain such divergent subject matter and the search for the invention of one group would not be required for the invention of the other groups.

Since the disclosed species are closely related, the restriction on that basis is hereby withdrawn. However, a review of claims indicates that the inventions are disclosed as combination, subcombination, method for connecting, and method for manufacturing. In view of this relationship among these inventions, the restriction requirement has been modified as attached.

Applicant's remarks with respect to the previous restriction requirement have been fully considered, but are not persuasive.

As it is indicated in the attached Election/Restriction requirement, the inventions of Groups I-IV have been shown to be related, but patentably distinct. Further, the burden to the examiner has been shown by the different classification of the inventions and the different searches required for the inventions.

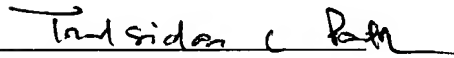
Upon receipt of proper reply to the election/restriction requirement, the case will be forwarded to the Examiner for continued prosecution on the merits.

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Any enquiry concerning this petition should be directed to Tulsidas C. Patel, Supervisory Patent Examiner, at (571) 272 2098.


Tulsidas C. Patel
Supervisory Patent Examiner
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